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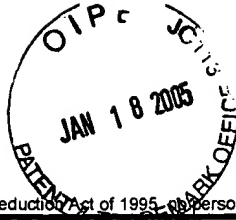
TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Application Number	09/886,200
Filing Date	June 21, 2001
First Named Inventor	Isamu Tobita
Art Unit	2854
Examiner Name	Minh H. Chau

Total Number of Pages in This Submission	12	Attorney Docket Number	JP920000070US1

ENCLOSURES   *(Check all that apply)*

[✓] Fee Transmittal Form

　　[ ] Fee Attached

[ ] Amendment/Reply

　　[ ] After Final

　　[ ] Affidavits/declaration(s)

[ ] Extension of Time Request

[ ] Express Abandonment Request

[ ] Information Disclosure Statement

[ ] Certified Copy of Priority Document(s)

[ ] Response to Missing Parts/ Incomplete Application

　　[ ] Response to Missing Parts under 37 CFR 1.52 or 1.53

[ ] Drawing(s)

[ ] Licensing-related Papers

[ ] Petition

[ ] Petition to Convert to a Provisional Application

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[ ] After Allowance communication to Technology Center (TC)

[ ] Appeal Communication to Board of Appeals and Interferences

[✓] Appeal Communication to TC **(Appeal Notice, Brief, Reply Brief)**

[ ] Proprietary Information

[ ] Status Letter

[ ] Other Enclosure(s) (please Identify below):

Remarks

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Winstead Sechrest & Minick P.C. Robert A. Voigt, Jr. / Reg. No. 47,169
Signature	
Date	January 12, 2005

CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.

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JAN 18 2005

PATENT & TRADEMARK OFFICE

Effective on 10/01/2004. Patent fees are subject to annual revision.

FEE TRANSMITTAL
For FY 2005

☐ Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT	($)

Complete if Known

Application Number	09/886,200
Filing Date	June 21, 2000
First Named Inventor	Isamu Tobita
Examiner Name	Minh H. Chau
Art Unit	2854
Attorney Docket No.	JP920000070US1

METHOD OF PAYMENT (check all that apply)

☐ Check   ☐ Credit Card   ☐ Money Order

☑ Deposit Account   ☐ None

Deposit Account Number	50-0563
Deposit Account Name	▪ IBM Corporation

The Director is hereby authorized to: (check all that apply)

☐ Charge fee(s) indicated below

☐ Charge fee(s) indicated below, **except for the filing fee**

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to the above–identified deposit account.

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FEE CALCULATION

1. BASIC FILING FEE

Fee Description	Fee ($)	Small Entity Fee ($)	Fee Paid($)
Utility Filing Fee	790	395	
Design Filing Fee	350	175	
Plant Filing Fee	550	275	
Reissue Filing Fee	790	395	
Provisional Filing Fee	160	80	

Subtotal (1) $

FEE CALCULATION (continued)

2. EXTRA CLAIM FEES

Fee Description	Fee ($)	Small Entity Fee ($)
Each claim over 20	50	25
Each independent claim over 3	200	100
Multiple dependent claims	360	180
For Reissues, each claim over 20 and more than in the original patent	50	25
For Reissues, each independent claim more than in the original patent	200	100

Total Claims	Extra Claims	Fee ($)	Fee Paid ($)
_____ - 20 or HP =	_____	x _____	= _____

HP = highest number of total claims paid for, if greater than 20

Indep. Claims	Extra Claims	Fee ($)	Fee Paid ($)
_____ - 3 or HP =	_____	x _____	= _____

HP = highest number of independent claims paid for, if greater than 3

Multiple Dependent Claims	Fee ($)	Fee Paid ($)
	_____	_____

Subtotal (2) $

3. OTHER FEES

Fee Description	Fee ($)	Small Entity Fee ($)	Fee Paid($)
1-month extension of time	120	60	
2-month extension of time	450	225	
3-month extension of time	1,020	510	
4-month extension of time	1,590	795	
5-month extension of time	2,160	1,080	
Information disclosure stmt. fee	180	180	
37 CFR 1.17(q) processing fee	50	50	
Non-English specification	130	130	
Notice of Appeal	500	250	
Filing a brief in support of appeal	500	250	
Request for oral hearing	1,000	500	
Other:_____			

Subtotal (3) $

SUBMITTED BY		
Signature	Registration No. (Attorney/Agent) 47,159	Telephone 512.370.2832
Name (Print/Type) Robert A. Voigt, Jr.		Date January 12, 2005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:	:	Before the Examiner:
Isamu Tobita	:	Chau, Minh H.
Serial No.: 09/886,200	:	Group Art Unit: 2854
Filed: June 21, 2001	:	
	:	Intellectual Property Law
Title: PRINTER, FORM PRINTER,	:	IBM Corporation 972/B656
PRINTER CONTROL METHOD AND	:	P.O. Box 12195
PRINT CONTROLLER	:	Research Triangle Park, NC 27709

January 12, 2005

REPLY BRIEF

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

    This Reply Brief is being submitted in response to the Examiner's Answer dated December 2, 2004, with a two-month statutory period for response set to expire on February 2, 2005.

I.   <u>RESPONSE TO EXAMINER'S ARGUMENTS</u>

       A.   <u>Response to Examiner's argument, as discussed on page 11 of Examiner's Answer, that Kikuchi and Ohsawa, taken together, teach or suggest "identifying a character set to be printed" as recited in claim 10.</u>

The Examiner asserts that Kikuchi teaches the limitation of "identifying a character set to be printed" in claim 10. Examiner's Answer, page 11. Appellant respectfully traverses. As the Examiner admitted, Kikuchi teaches that the Central Processing Unit (CPU) 101 controls the operation of the printer. Column 1, lines 15-16. Kikuchi further teaches that CPU 101 communicates with other parts of the printer via an integrated I/O circuit which transfers signals from the printer's control panel to CPU 101 to a timer circuit, a drive circuit, a line-feed motor and a spacing motor. Column 1, lines 16-24. There is no language in Kikuchi that teaches that CPU 101 identifies a character set to be printed. The Examiner seems to imply that a person of ordinary skill in the art would interpret Kikuchi as teaching that CPU 101 identifies a character set to be printed. Examiner's Answer, page 11. However, the Examiner has not provided any evidence to support such an interpretation. The Examiner must provide a basis in fact and/or technical reasoning to support the assertion that a person of ordinary skill in the art would interpret CPU 101 of Kikuchi as identifying a character set to be printed. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). That is, the Examiner must provide extrinsic evidence that must make clear that CPU 101 of Kikuchi identifies a character set to be printed, and that it be so recognized for persons of ordinary skill. *In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999). Since the Examiner has not provided such evidence, the Examiner has not provided a *prima facie* case of obviousness in rejecting claim 10. M.P.E.P. §2143.

Furthermore, the Examiner seems to suggest that the limitation of "character set" is a broad term and accordingly the Examiner may construe the limitation broadly. Examiner's Answer, page 11. Appellant notes that the Examiner must give claim limitations their broadest <u>reasonable</u> interpretation consistent with the specification.

Rapoport v. Dement, 59 U.S.P.Q.2d 1215, 1220 (Fed. Cir. 2001); *In re Hyatt*, 54 U.S.P.Q.2d 1664, 1667 (Fed. Cir. 2000).

  B. <u>Response to Examiner's argument, as discussed on page 11 of Examiner's Answer, that Kikuchi and Ohsawa, taken together, teach or suggest "a data analyzer, for determining the type of character set included in print data" as recited in claim 11.</u>

The Examiner asserts that Kikuchi teaches the limitation of "a data analyzer, for determining the type of character set included in print data" in claim 10. Examiner's Answer, page 11. Appellant respectfully traverses. As the Examiner admitted, Kikuchi teaches that the Central Processing Unit (CPU) 101 controls the operation of the printer. Column 1, lines 15-16. Kikuchi further teaches that CPU 101 communicates with other parts of the printer via an integrated I/O circuit which transfers signals from the printer's control panel to CPU 101 to a timer circuit, a drive circuit, a line-feed motor and a spacing motor. Column 1, lines 16-24. There is no language in Kikuchi that teaches that CPU 101 determines the type of character set included in print data. The Examiner seems to imply that a person of ordinary skill in the art would interpret Kikuchi as teaching that CPU 101 determines the type of character set included in print data. Examiner's Answer, page 11. However, the Examiner has not provided any evidence to support such an interpretation. The Examiner must provide a basis in fact and/or technical reasoning to support the assertion that a person of ordinary skill in the art would interpret CPU 101 of Kikuchi as determining the type of character set included in print data. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). That is, the Examiner must provide extrinsic evidence that must make clear that CPU 101 of Kikuchi determines the type of character set included in print data, and that it be so recognized for persons of ordinary skill. *In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999). Since the Examiner has not provided such evidence, the Examiner has not provided a *prima facie* case of obviousness in rejecting claim 11. M.P.E.P. §2143.

C.   Response to Examiner's argument, as discussed on pages 11-12 of Examiner's Answer, that the Examiner has presented objective evidence in combining Kikuchi with Ohsawa.

The Examiner has not presented a source of motivation for modifying Kikuchi with Ohsawa. The Examiner states that the motivation to modify Kikuchi with Ohsawa (1) to have an impact force controller for changing the force with which the pins impact in accordance with the settings for characters that are to be printed, as recited in claim 1 and similarly in claims 2, 4 and 6; (2) to generate impact power to the pins in accordance with the types of the identified character set, as recited in claim 10; and (3) to have a print header controller for employing the determination results obtained by the data analyzer to change the impact force transferred by the pins, as recited in claim 11, is "so that the design density for a selected character can be achieved." Paper No. 11, pages 3 and 5; Examiner's Answer, page 12. The motivation to modify Kikuchi with Ohsawa must come from one of three possible sources: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998). The Examiner has not provided any evidence that his motivation comes from any of these sources. Instead, the Examiner is relying upon his own subjective opinion which is insufficient to support a *prima facie* case of obviousness. *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002). Consequently, the Examiner's motivation is insufficient to support a *prima facie* case of obviousness for rejecting claims 1-6 and 10-13. *Id.*

D.   Response to Examiner's argument, as discussed on pages 12-13 of Examiner's Answer, that by combining Kikuchi with Ohsawa, the principle of operation of Kikuchi would not change.

As understood by the Appellant, the Examiner admits that Kikuchi would no longer be able to generate signals indicating the position of the print wires. As stated in Appellant's Supplemental Appeal Brief, the purpose of Kikuchi is to control the printing force with a high reproducibility to ensure printing with an optimum printing force. Kikuchi controls the printing force with a high reproducibility to ensure printing with an

optimum printing force by generating signals indicating the position of the print wires. Since Kikuchi would no longer be able to generate signals indicating the position of the print wires, Kikuchi would no longer be able to control the printing force with a high reproducibility to ensure printing with an optimum printing force. Hence, by modifying Kikuchi with Ohsawa, the principle of operation in Kikuchi would change, and subsequently render the operation of Kikuchi to perform its purpose unsatisfactorily. Therefore, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 1-6 and 10-13. *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (C.C.P.A. 1959); *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984).

      E.   <u>Response to Examiner's argument, as discussed on pages 13-14 of Examiner's Answer, that Kikuchi, Ohsawa and IBM Disclosure Bulletin, taken together, teach the limitation of "a data analyzer, for determining the type of character set included in print data in accordance with the predetermined command that is entered when a character font is to be changed" as recited in claims 12 and 13.</u>

The Examiner asserts that Kikuchi in combination with Ohsawa and IBM Disclosure Bulletin teach the limitation of "a data analyzer, for determining the type of character set included in print data in accordance with the predetermined command that is entered when a character font is to be changed" as recited in claims 12 and 13. Examiner's Answer, pages 13-14. However, the Examiner cited element 101 and columns 1-6 in Kikuchi as teaching determining the type of character set included in print data. Paper No. 11, page 7. The Examiner has not cited to any passage in either Ohsawa or the IBM Disclosure Bulletin as teaching determining the type of character set included in print data. In order to establish a *prima facie* case of obviousness, the Examiner must cite a prior art reference (or references when combined) that teach or suggest all of the claim limitations including the above-cited claim limitation. M.P.E.P. §2143. Kikuchi does not teach the limitation of determining the type of character set included in print data for at least the reasons discussed above and in Appellant's Supplemental Appeal Brief. Accordingly, the Examiner has not presented a *prima facie* case of obviousness in rejecting claims 12 and 13 since the Examiner is relying upon an incorrect, factual

predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

F. <u>Response to Examiner's argument, as discussed on pages 14-16 of Examiner's Answer, that the Examiner has presented objective evidence in combining Kikuchi with Ohsawa and the IBM Disclosure Bulletin.</u>

The Examiner has not presented a source of motivation for modifying Kikuchi with Ohsawa and the IBM Disclosure Bulletin. The Examiner states that the motivation to modify Kikuchi with Ohsawa and the IBM Disclosure Bulletin to change the moving velocity of the pins to alter the impact force, as recited in claim 5, is "so that the impact force for the selected character can be precisely achieved." Paper No. 11, page 5. The Examiner's motivation for modifying Kikuchi with Ohsawa and the IBM Disclosure Bulletin for employing the determination results by the data analyzer to change the impact force transferred by the pins, as recited in claims 12 and 13, is "so that the print quality of a variety of character font can be achieved." Paper No. 11, page 8; Examiner's Answer, page 16. These motivations to modify Kikuchi with Ohsawa and the IBM Disclosure Bulletin must come from one of three possible sources: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998). The Examiner has not provided any evidence that his motivations come from any of these sources. Instead, the Examiner is relying upon his own subjective opinion which is insufficient to support a *prima facie* case of obviousness. *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002). Consequently, the Examiner's motivation is insufficient to support a *prima facie* case of obviousness for rejecting claims 5 and 12-13. *Id*.

G. <u>Response to Examiner's argument, as discussed on page 16 of Examiner's Answer, that the Examiner has presented a reasonable expectation of success in combining Kikuchi with the IBM Disclosure Bulletin.</u>

The Examiner acknowledges that Kikuchi teaches a dot matrix printer and that the IBM Disclosure Bulletin teaches a typewriter. Examiner's Answer, page 16. The

Examiner though concludes there is a reasonable expectation of success in combining a dot matrix printer with a typewriter by focusing on the electronic control of the print impact as taught in the IBM Disclosure Bulletin. Examiner's Answer, page 16. The Examiner cannot ignore the entire teachings of the IBM Disclosure Bulletin including the aspect that the IBM Disclosure Bulletin teaches a typewriter. The Examiner must consider the prior art reference, the IBM Disclosure Bulletin, in its entirety, i.e., as a whole. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984); M.P.E.P. §2141.02. The Examiner must present evidence that shows a reasonable expectation of success in combining Kikuchi, which teaches a dot matrix printer, with the IBM Disclosure Bulletin, which teaches a typewriter with electronic control of the print impact, in order to establish a *prima facie* case of obviousness. M.P.E.P. §2143.02. Since the Examiner has not provided such evidence, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 5 and 12-13. M.P.E.P. §2143.02.

H.   Response to Examiner's argument, as discussed on pages 16-17 of Examiner's Answer, that Kikuchi and Kobayashi, taken together, teach the limitation of "wherein the impact force is set to a mode at one of a plurality of levels, and the impact force controller changes the mode in accordance with the number of dots that are arranged across the widths of lines forming an object image" as recited in claim 8.

The Examiner asserts that Kikuchi in combination with Kobayashi teach the limitation of "wherein the impact force is set to a mode at one of a plurality of levels, and the impact force controller changes the mode in accordance with the number of dots that are arranged across the widths of lines forming an object image" as recited in claim 8. Examiner's Answer, page 17. However, as understood by the Appellant, the Examiner cites columns 3-5 of Kobayashi as teaching the above-cited claim limitation. Paper No. 11, page 6. The Examiner has not cited to any specific passage in Kikuchi as teaching any portion of the above-cited claim limitation. In order to establish a *prima facie* case of obviousness, the Examiner must cite a prior art reference (or references when combined) that teach or suggest all of the claim limitations including the above-cited

claim limitation. M.P.E.P. §2143. Kobayashi does not teach the above-cited limitation for at least the reasons discussed in Appellant's Supplemental Appeal Brief. Accordingly, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 8 since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

I.   Response to Examiner's argument, as discussed on pages 16-17 of Examiner's Answer, that Kikuchi and Kobayashi, taken together, teach the limitation of "wherein, the command for changing the mode is included in print data for a character, and the impact force controller changes the mode in response to said mode" as recited in claim 9.

The Examiner asserts that Kikuchi in combination with Kobayashi teach the limitation of "wherein, the command for changing the mode is included in print data for a character, and the impact force controller changes the mode in response to said mode" as recited in claim 9. Examiner's Answer, page 17. However, as understood by the Appellant, the Examiner cites columns 3-6 of Kobayashi as teaching the above-cited claim limitation. Paper No. 11, page 7. The Examiner has not cited to any specific passage in Kikuchi as teaching any portion of the above-cited claim limitation. In order to establish a *prima facie* case of obviousness, the Examiner must cite a prior art reference (or references when combined) that teach or suggest all of the claim limitations including the above-cited claim limitation. M.P.E.P. §2143. Kobayashi does not teach the above-cited limitation for at least the reasons discussed in Appellant's Supplemental Appeal Brief. Accordingly, the Examiner has not presented a *prima facie* case of obviousness in rejecting claim 9 since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

J.   Response to Examiner's argument, as discussed on pages 17-18 of Examiner's Answer, that the Examiner has presented objective evidence in combining Kikuchi with Kobayashi.

The Examiner has not presented a source of motivation for modifying Kikuchi

with Kobayashi. The Examiner states that the motivation to modify Kikuchi with Kobayashi to change the impact force exerted by the plurality of pins in accordance with the number of dots that are arranged across the widths of lines forming the print image, as recited in claims 7-8, is "so that the thickness or the print density of a selected character or image can be consistency maintained." Paper No. 11, page 6. The Examiner also states as motivation for modifying Kikuchi with Kobayashi to change the impact force exerted by the plurality of pins in accordance with the number of dots that are arranged across the widths of lines forming the print image, as recited in claims 7-8, is "so that the quality of a design density of a selected characters or setting characters can be achieved." Examiner's Answer, page 18. These motivations to modify Kikuchi with Kobayashi must come from one of three possible sources: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art. *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1457-58 (Fed. Cir. 1998). The Examiner has not provided any evidence that his motivations come from any of these sources. Instead, the Examiner is relying upon his own subjective opinion which is insufficient to support a *prima facie* case of obviousness. *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002). Consequently, the Examiner's motivation is insufficient to support a *prima facie* case of obviousness for rejecting claims 7-9. *Id.*

K.   Other matters raised by the Examiner.

All other matters raised by the Examiner have been adequately addressed above and in Appellant's Appeal Brief and in Appellant's Supplemental Appeal Brief and therefore will not be addressed herein for the sake of brevity.

II. CONCLUSION

For the reasons stated in Appellant's Appeal Brief and in Appellant's Supplemental Appeal Brief and noted above, Appellant respectfully asserts that the rejections of claims 1-13 are in error. Appellant respectfully requests reversal of the rejections and allowance of claims 1-13.

Respectfully submitted,

WINSTEAD SECHREST & MINICK P.C.

Attorneys for Appellant

By:_____

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